SUPPORT FOR AMENDMENTS

Support for the amendments to claim 1 can be found in the specification at page 5, lines 2-5. Support can also be found at this point in the specification for the amendments to the claims dependent therefrom. Support for the amendment to claim 19 and newly added claim 20 can be found in Table 1 of the specification.

No new matter has been added.

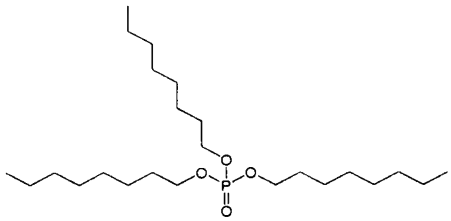
REMARKS/ARGUMENTS

The present claims relate to lubricating oils having at least one acid phosphite ester compound as an extreme-pressure agent. There is no disclosure of such compositions in the cited references, and thus no disclosure that such compositions would show excellent degreasing efficiencies.

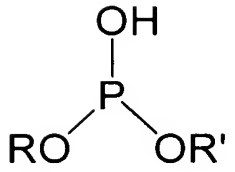
Rejection under 35 U.S.C. §102(b)

The rejection of claims 1-6, 9, 10 and 19 under 35 U.S.C. § 102(b) in view of US 2003/0153472 ("*Nagano*") has been obviated by amendment. There is no disclosure of any extreme pressure agents that are acid phosphite esters.

The Office considers that the "trioctyl phosphate" in Table 4 of *Nagano* is encompassed by the limitations of present claim 1. However, "trioctyl phosphate" has a structure of



On the other hand, the "acid phosphite ester[s]" of the present claims have general structures of



where R and R' are each some group and may be the same or different. Therefore, the "trioctyl phosphate" of *Nagano* is not encompassed by the limitations of the present claims (see claims 1, 13 & 19).

Accordingly, the rejection is no longer tenable and should be withdrawn.

Rejections under 35 U.S.C. § 103(a)

The rejection of claims 7-8 under 35 U.S.C. § 103(a) in view of *Nagano* and JP 09-222125 ("*Masao*") is respectfully traversed. Claims 7 and 8 (ultimately) depend from claim 1. As noted above, *Nagano* contains no disclosure of acid phosphite esters and therefore contains no disclosure of the presently claimed lubricating oils. Neither does *Masao*. Therefore, the presently claimed lubricating oils and methods of using the same would not have been obvious to one of ordinary skill in the art.

Accordingly, the rejection is no longer tenable and should be withdrawn.

The rejection of claims 11-17 under 35 U.S.C. § 103(a) in view of *Nagano* and US 2002/0114980 ("*Gunsel*") is respectfully traversed. These claims (ultimately) depend from claim 1. As is the case for *Nagano*, there is no disclosure of acid phosphite esters in *Gunsel*. Thus, the presently claimed lubricating oils are not disclosed in either cited reference.

Moreover, the presently claimed lubricating oils provide more efficiency during use, which is attributed to the presence of acid phosphite esters:

> Above, all, the phosphorous acid ester compounds including a phosphite ester and ***an acid phosphite ester*** are preferable from the standpoint of degreasing efficiency.

See last sentence of [0011] of the present specification, emphasis added. Too little or too much of the extreme-pressure agent (*i.e.* the acid phosphite ester compound) leads to poor machinability and poor degreasing efficiency:

> An amount of the component (B) less than 0.1 % by mass causes poor machinability. Too large an amount in excess of 10 % by mass causes poor degreasing efficiency.

See [0017] of the present specification. These trends are shown in the compositions of Examples 1-5 and 8, where the residual amount of oil is at most 0.0057g (see claims 19 & 20):

TABLE 1

			Ex. 1	Ex. 2	Ex. 3	Ex. 4	Ex. 5	Ex. 6	Ex. 7	Ex. 8
Degreasing efficiency	Degreasing Test	Residual amount of Oil (g)	0.0057	0.0023	0.0012	0.0006	0.0017	0.0125	0.0516	0.0014

Table 1, in part, of the publication of the present application—US 2007/0149416, boxes added for discussion purposes only. Thus, Applicants have demonstrated that the lubricating oils of the present claims exhibit large degreasing efficiencies because only a minor amount of oil remains upon use.

Neither *Nagano* nor *Gunsel*, either individually or combined, disclose the acid phosphite esters of the present claims; nor do these cited references disclose any degreasing efficiencies. Thus, these cited references, individually or combined, would not suggest to one of ordinary skill in the art the particular lubricating oils of the present claims nor suggest that such compositions would be exhibit large degreasing efficiencies.

Accordingly, the rejection is no longer tenable and should be withdrawn.

The rejection of claims 15-17 under 35 U.S.C. § 103(a) in view of *Nagano* and US 5,275,630 ("*Dorer*") is respectfully traversed for the same reasons give above. Moreover, *Dorer* contains no disclosure of acid phosphite esters, states that: "[t]he invention also

includes a means for stabilizing a fuel against oxidation during storage..." Col. 3:23-24 of *Dorer*. There is no disclosure of degreasing efficiencies. Thus, these cited references, individually or combined, would not suggest to one of ordinary skill in the art the particular lubricating oils of the present claims nor suggest that such compositions would be exhibit large degreasing efficiencies.

Accordingly, the rejection is no longer tenable and should be withdrawn.

The rejection of claims 18 under 35 U.S.C. § 103(a) in view of *Nagano* and US 6,586,376 ("*Nakanishi*") is respectfully traversed for the same reasons give above. There is no disclosure of the acid phosphite esters of the present claims. These cited references, individually or combined, would not suggest to one of ordinary skill in the art the particular lubricating oils of the present claims nor suggest that such compositions would be exhibit large degreasing efficiencies.

Accordingly, the rejection is no longer tenable and should be withdrawn.

Conclusion

Applicants respectfully submit that the above-identified application is in condition for allowance. Notification thereof is requested.

Respectfully submitted,

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